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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/828,977 | 04/21/2004 | Hiroshi Kanto | 9683/188 | 5406 |

7590 11/21/2005
Brinks Hofer Gilson & Lione
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Chicago, IL 60610

EXAMINER

FOX, BRYAN J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2686

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/828,977

Applicant(s)

KANTO ET AL.

Examiner

Bryan J. Fox

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Kransmo (US006594242B1).

Regarding **claim 1**, Kransmo discloses a system with a mobile station that may comprise a dual mode mobile terminal, capable of being used in both 3G and 2G networks (see column 3, lines 62-67), which reads on the claimed, "radio terminal comprising: communication means having a communication function for using a first mobile communication network and a second mobile communication network." The control channel information is provided regarding a 2G communication system within a downlink control channel of the 3G communication system to the wireless terminal (see column 5, lines 21-36) and the MS takes measurements of the carrier channels such as signal strength, and also determines if the correct cell has been selected (see column 4, lines 20-29), which reads on the claimed, "determination means for determining, when said mobile terminal is registered to said second mobile communication network, whether it is possible to register to said first mobile communication network, on the

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basis of notification information transmitted from said second mobile communication network.”

Regarding **claim 3**, Kransmo discloses a system with a mobile station that may comprise a dual mode mobile terminal, capable of being used in both 3G and 2G networks (see column 3, lines 62-67), which reads on the claimed, “communication system comprising: a first mobile communication network; a second mobile communication network having a base station.” The control channel information is provided regarding a 2G communication system within a downlink control channel of the 3G communication system to the wireless terminal (see column 5, lines 21-36) and the MS takes measurements of the carrier channels such as signal strength, and also determines if the correct cell has been selected (see column 4, lines 20-29), which reads on the claimed, “transmitting notification information indicating that it is possible to register to said first mobile communication network.” Kransmo inherently provides support for “a management device, in accordance with location registration of a mobile terminal to either said first mobile communication network or said second mobile communication network, for storing data in correlation with a identifier of the mobile terminal, the data indicating a mobile communication network to which the mobile terminal is registered,” as a person of ordinary skill in the art would recognize that by registering with a network, an indicator associated with the mobile phone would be set indicating the registration status of the mobile phone.

Regarding **claim 4**, Kransmo discloses a system with a mobile station that may comprise a dual mode mobile terminal, capable of being used in both 3G and 2G

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networks (see column 3, lines 62-67). The control channel information is provided regarding a 2G communication system within a downlink control channel of the 3G communication system to the wireless terminal (see column 5, lines 21-36) and the MS takes measurements of the carrier channels such as signal strength, and also determines if the correct cell has been selected (see column 4, lines 20-29), which reads on the claimed, "first step of determining in a mobile terminal whether it is possible to register to a first mobile communication network on the basis of notification information received from a second mobile communication network, the mobile terminal having a communication function for using the first mobile communication network and the second mobile communication network." Kransmo inherently provides support for "a second step of transmitting from said mobile terminal to said first mobile communication network, a notification including an identifier, in a case that said determination is positive; and a third step of receiving in a management device a notification transmitted by the mobile terminal is said second step through said first mobile communication network, and storing in said management device data indicating that said mobile terminal is registered to said first mobile communication network, the mobile terminal being specified by an identifier included in said notification," as a person of ordinary skill in the art would recognize that by registering with a network, an indicator associated with the mobile phone would be set indicating the registration status of the mobile phone.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kransmo in view of Hicks (US006493552B1) and further in view of what was well known in the art (see MPEP 2144.03).

Regarding **claim 2**, Kransmo fails to disclose notification information received by said communication means includes timing information indicating a maximum number of times for attempting to register to said first mobile communication network, and said attempt means attempts to register to said first mobile communication network on the basis of said timing information.

In a similar field of endeavor, Hicks discloses a system where a mobile station has a maximum number of times it may register (see column 5, lines 23-62), which

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reads on the claimed, "maximum number of times for attempting to register to said first mobile communication network."

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Kransmo with Hicks to include the above maximum number of times to attempt to register in order to conserve battery power and conserve system resources.

The combination of Kransmo and Hicks fails to disclose that the maximum number of times to attempt registration is received by said communication means.

The examiner takes official notice that receiving system parameters by the communication means was well known to a person of ordinary skill in the art at the time of the invention.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Kransmo and Hicks to include the above receiving of system parameters in order to adjust the mobile phone to conform to the standards of the network.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan J. Fox whose telephone number is (571) 272-7908. The examiner can normally be reached on Monday through Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (571) 272-7905. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bryan Fox
November 14, 2005

Marsha D Banks-Harold

MARSHA D. BANKS-HAROLD
SUPERVISORY PATENT EXAMINER
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